

REMARKS

The Applicant is filing this Amendment and Response in response to an Office Action dated December 12, 2008. At the time of the Office Action, claims 1, 3-15, 17, 18, 20-22 and 25-28 were pending. By way of this Amendment and Response, claims 22, 25, and 26 are canceled and new claims 29-34 are added. No new matter is included by these amendments. Accordingly, claims 1, 3-15, 17, 18, 20-21, and 27-34 are currently pending. Based on the following remarks, the Applicant asserts that all pending claims are in condition for allowance.

In the Office Action, the Examiner rejected claims 1, 13, 22, and 27 under 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement. The Examiner rejected claims 1, 3, 5, 7, 11-13, 17, 22, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,202,211 to Williams, Jr. (hereinafter “Williams ‘211”) and U.S. Patent Application Publication No. 2003/0048757 by Accarie, et al. (hereinafter “Accarie”) in view of U.S. Patent Application Publication No. 2004/0049797 by Salmonsen (hereinafter “Salmonsen”). The Examiner also rejected claims 4, 6, 8, 14, 15, 18, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Williams ‘211 and Accarie in view of Salmonsen and in view of U.S. Patent Application Publication No. 2002/0056118 by Hunter et al. (hereinafter “Hunter”). Finally, the Examiner rejected claims 9, 10, 20, 21, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Williams ‘211 in view of Accarie and Salmonsen and in view of Hunter and U.S. Patent Application Publication No. 2004/0019908 by Williams et al. (hereinafter “Williams ‘908”). These rejections are discussed in detail below.

As a preliminary matter, the Applicants note that claim 22, and its respective dependent claims 25 and 26, have been canceled. Thus, the rejections of these claims are considered to be moot and the claims are not discussed further herein.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

With respect to the rejections of claims 1, 13, and 27 under 35 U.S.C. § 112, the Examiner alleged that “there is absolutely no support for the existence of a second presentation device that is coupled to a sink component.” Office Action, p. 3. The Applicant respectfully traverses this rejection. To reject a claim under the first paragraph of 35 U.S.C. § 112, the Examiner has the burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). If the specification contains a teaching of the manner and process of making and using an invention in terms corresponding in scope to those used in the claims, then the claims are in compliance with the enablement requirement of the first paragraph of 35 U.S.C. § 112. *See* M.P.E.P. § 2164.04. In other words, the only standard as to whether a claim is enabled by the specification is whether the experimentation needed to practice the invention is undue or reasonable. *See Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); M.P.E.P. § 2164.01.

Independent claims 1, 13, and 27 are fully described by the specification.

The Applicant respectfully disagrees with the Examiner that the present specification does not describe the claims. The Examiner’s assertion that there no support for the existence of a second presentation device is patently incorrect. A second presentation device is clearly shown in Fig. 2 of the present application. The second presentation device is also clearly described in the specification, which states that “[a]n output device 52 may be used to receive information from sink component 12 via interface 42 such as, but not limited to, a visual monitor, display or speaker.” Specification, para. [0025].

The Examiner has also asserted that even if Fig. 2 illustrates the claimed material, there is “NO distinction between the 1st and 2nd presentation device coupled to the sink component . . . said presentation devices *may be* within the same I/O component . . . [and] according to the figure enumeration (i.e., the presentation device =element 14) there is no distinguishing between presentation devices.” Office Action,

p. 4 (emphasis added). However, the input device 50 and the output device 52 do *not* have to be a single unit, as described by the specification: “[i]n FIG. 2, input device 50 and output device 52 are illustrated as separate components; however, it should be understood that input and output functions *may be* provided in a single device.” *Id.* (emphasis added). In contrast to the Examiner’s assertion, nothing in the specification indicates that the input device 50 and output device 52 are *required* to be a single device. Thus, one of ordinary skill in the art would recognize that the input device 50 and output device 52 may be separate or, alternatively, may be combined into a single unit. Thus, the claims directed to a first presentation device and a second presentation device are fully supported by the description of a separate input device and output device, each having a presentation device.

Furthermore, the specification does not require that every occurrence of the presentation device 14 be the same unit, as implied by the Examiner. In fact, the specification clearly describes that the presentation device 14 “may comprise any device for presenting audio/video (A/V) program data to a user such as, but not limited to, speakers, a computer, a monitor, a television, a stereo system, or a combination of the foregoing, for performing, playing, or otherwise presenting A/V program data to a user.” Specification, para. [0019]. Thus, the presentation device 14 in the input device 50 may comprise a first device selected from the list, while the presentation device 52 may be a second device selected from the list.

For at least these reasons, the Applicant respectfully requests withdrawal of the rejections of independent claims 1, 13, and 27 under the first paragraph of 35 U.S.C. § 112. Moreover, the respective dependent claims of independent claims 1, 13, and 27 are also allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. § 103(a)

With regard to the rejection of independent claims 1, 13, and 27 under 35 U.S.C. § 103(a), the Examiner admitted that “the references of Williams and Accarie . . . are unclear on use of menu on one presentation device, and receiving from

corresponding source on second presentation device.” Office Action, p. 7. However, the Examiner claimed that Salmonsen “does show a sink component receiving menu data for display (see Salmonsen, fig. 3, 4) and another presentation device receiving program data from a corresponding source.” *Id.* The Examiner made similar allegations with respect to independent claims 13 and 27. *See id.* at p. 9 and pp. 10-11. The Applicant respectfully traverses this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Although a showing of obviousness under 35 U.S.C. § 103 does not require an express teaching, suggestion or motivation to combine prior art references, such a showing has been described by the Federal Circuit as providing a “helpful insight” into the obviousness inquiry. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007). Moreover, obviousness cannot be established by a mere showing that each claimed element is present in the prior art. *Id.* The Examiner must cite a compelling reason why a person having ordinary skill in the art would combine known elements in order to support a proper rejection under 35 U.S.C. § 103. *Id.*

The cited references, alone or in any sort of hypothetical combination, fail to disclose all of the elements of independent claims 1, 13, and 27.

As previously presented, independent claim 1 recites, *inter alia*, “the sink component adapted to display *on the first presentation device* a menu presenting the A/V program data available,” and “the sink component adapted to control presentation of desired A/V program data selected from the menu of A/V program data and received from the corresponding source component *on the second presentation device*.” (Emphasis added). Similarly, independent claims 13 and 27 generally recite displaying the A/V program data available from each of a plurality of source

components “on a first presentation device,” and displaying “desired A/V program data” on a “second presentation device.”

In contrast, none of the cited references, Williams '211, Accarie, or Salmonsens, alone or in any hypothetical combination discloses displaying the A/V program data available on a first presentation device and the A/V information on a second presentation device. The Examiner admitted that Williams '211 and Accarie “are unclear on use of menu on one presentation device, and receiving from corresponding source on second presentation device.” Office Action, p. 7. However, the Examiner claimed that “Salmonsens … does show a sink component receiving menu data for display (see Salmonsens, fig. 3, 4) and another presentation device receiving program data from a corresponding source.” *Id.* However, the Applicant respectfully asserts that nothing in figures 3 and 4 of Salmonsens discloses that the available A/V programs from the plurality of sources is displayed on a first presentation device and the A/V information is presented on a second presentation device. Thus, the cited references, alone or in any hypothetical combinations, do not disclose all of the elements of independent claims 1, 13, and 27.

Further, in a Response to Arguments, the Examiner asserted that Williams '211 discloses “a presentation device that shows the menu of A/V data for the user and also a presentation device that displays the A/V data selected for the user to experience (see Williams, fig. 2, col. 4, ll. 13-65).” Office Action, p. 2. However, neither the cited figure nor the cited text appears to disclose displaying the menu information on a first presentation device and displaying the A/V information on a second presentation device. Instead, Williams '211 shows a system in which both the menu and selected A/V information is displayed on a single presentation device. Similarly, the portion of Salmonsens cited by the Examiner, “fig. 12, 13 and [167-171],” does not disclose that menu and A/V information are displayed on separate presentation devices. Finally, the Examiner stated Accarie showed “a presentation device that shows a menu of A/V data for the user and a presentation device that displays the A/V data selected for the user to experience (see Accarie, fig. 10, 11,

[406-408], at local node and terminal chosen).” Office Action, p. 3. However, the cited figures merely show a remote control, which is not a presentation device as described in the present application. *See Specification, para. [0025].*

For at least the reasons discussed above, none of the cited references, alone or in any sort of hypothetical combinations, disclose all of the elements of independent claims 1, 13, and 27. Accordingly, independent claims 1, 13, and 27 are allowable over these references.

Further, the deficiencies of Williams '211, Accarie, or Salmonsen with respect to independent claims 1, 13, and 27 are not remedied by any of the secondary references cited against various dependent claims, i.e., Hunter or Williams '908. For example, claims 9, 10, 20, and 21 are generally addressed to filtering the A/V program data from the source, based on the content or on the type of the second presentation device coupled to the sink component. As stated in the specification “aggregator 62 filters the available A/V program data 32 and presents or displays to the user via user interface 42 *only the types of A/V program data 32 capable of being displayed or presented via the particular presentation device 14.*” Specification, para. 31 (emphasis added). The Examiner admitted that this is not taught in Williams '211, Accarie, or Salmonsen, but claimed that it is taught in Williams '908, i.e., “Chris Williams.” However, the Applicant respectfully asserts that the cited figure of Williams '908 does not teach filtering the menu of content available based on the presentation device. Indeed, all of the content shown in figure 5 of Williams '908 is apparently audio content. Further, nothing in the text of Williams '908 discloses limiting a menu of available content based on a type of an attached presentation device. Thus, for at least this further reason, Williams '908, either alone or in any sort of hypothetical combination with Williams '211, Accarie, or Salmonsen, discloses all of the elements of claims 9, 10, 20, and 21.

Thus, for at least the same reasons as discussed above, claims 3-12, 14, 15, 17, 18, 20, 21, and 28, which depend from claims 1, 13, and 27, respectively, are

allowable. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103 and allow the claims to issue.

The Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. 103(a).

As set forth above, none of the references relied upon by the Examiner, either alone or in any sort of hypothetical combination, discloses all of the elements of claims 1, 3-15, 17, 18, 20-21, 27, and 28. Accordingly, withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested. Moreover, an indication of the allowability of those claims is earnestly solicited.

New claims 29-34.

As set forth above, new claims 29-34 are presented for examination herein. The Applicant respectfully submits that new claims 29-34 are in condition for allowance. Accordingly, an indication of the allowability of new claims 29-34 is earnestly solicited.

Conclusion

The Applicant respectfully asserts that all pending claims are in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: March 10, 2008

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